

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN J. COLLINS

Appeal No. 96-3919
Application 08/224,163¹

ON BRIEF

Before CALVERT, LYDDANE and STAAB, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

Stephen J. Collins (appellant) appeals from the final rejection of claims 1-5 and 12-14, all the claims remaining in the application.

¹Application for patent filed April 7, 1994.

Appellant's invention pertains to the combination of a writing implement and a cap for removably receiving the writing tip of the writing implement (claims 1-5 and 14)², and a cap for removably receiving the writing tip of a writing implement (claims 12 and 13). The cap includes a blade portion for receipt between the pages of a book for acting as a bookmark. Independent claim 1 is illustrative of the appealed subject matter and reads as follows:

1. In combination:

a writing implement comprising an elongated body and a writing instrument situated at one end of said body; and

a cap comprising a body portion and a recess in said body portion for removably receiving a tip of said writing instrument when not in use, said cap further including an arm portion extending outwardly from said body portion and a blade portion extending downwardly from said arm portion so as to be positioned in spaced relation to said writing implement when said cap is assembled with said writing implement, said blade portion extending in a plane which is generally perpendicular to a centerline of said body portion.

said cap being slidably received over a spine of a book wherein said blade portion of said cap extends downwardly between pages of a book and said writing implement extends downwardly along an outside surface of a book spine.

²The preamble of dependent claims 2-4 is inconsistent with the preamble of claim 1, from which these claims depend. For purposes of this appeal, we have interpreted claims 2-4 as being directed to "The combination of claim 1," In the event of further prosecution, this inconsistency should be rectified.

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The references of record relied upon by the examiner in support of a rejection under 35 U.S.C. § 103 are:

Neidhardt et al. (Neidhardt)	3,733,139	May 15, 1973
British Patent (Downes)	8,626	May 20, 1891
German Patent (Manzardo)	13,735	May 17, 1956 ³

Claims 12 and 13 stand rejected under 35 U.S.C. § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (answer, page 3).

Claims 1-5 and 12-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over British Patent No. 8,626 to Downes in view of German Patent No. 13,735 to Manzardo and further in view of Neidhardt.

The 35 U.S.C. § 112, Second Paragraph, Rejection

Considering first the 35 U.S.C. § 112, second paragraph, rejection, the examiner correctly notes that the term "said blade portion" in claim 12 and the term "said arm portion" in claim 13 lack a proper antecedent basis. Based on these examples of claim deficiencies, the examiner concludes that claims 12 and 13 are indefinite.

³Our understanding of this German language patent is derived from a translation prepared in the Patent and Trademark Office, a copy of which is appended to this opinion.

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In response, appellant states on page 4 of the brief that "[he] does not contest the formal nature of this rejection" and that the terms in question were intended to be "the arm" and "the blade." Appellant further offers to make such amendments to the claims, if required, upon resolution of this appeal.

Since appellant has not pointed out how the examiner has erred in the rejection of claims 12 and 13 under 35 U.S.C. § 112, second paragraph, and has in effect acquiesced to the rejection, we are constrained to sustain this rejection.

The 35 U.S.C. § 103 Rejection

In rejecting the appealed claims under 35 U.S.C. § 103, the examiner states:

British Patent #8626 discloses substantially similar structure [as appellant], see Figure 2. It is noted that using the blade portion to mark is merely intended use . . . and does not structurally distinguish over the art The German Patent discloses using the blade portion for marking, while Niedharedt [sic] et al discloses a ball point and highlight marker. It would have been obvious to a mechanic with ordinary skill in the art to use these teachings. The motivation is provided by the references. [answer, page 4]

In the "Response to argument" section of the answer, the examiner further states:

The German Patent clearly discloses a blade similar to appellant's in Figures [sic] 2 and Figure 6. Figure 6 additionally discloses marking pages with such a blade. It would have been obvious . . . to substitute such a blade to [sic] the primary reference.

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The motivation is to mark pages as shown in Figure 6 of the German Patent. [answer, page 5]

At the outset, we cannot agree with the examiner that using the blade portion as a bookmark is "merely intended use . . . and does not structurally distinguish over the art." The last paragraph of each of the independent claims on appeal *positively recites* that the blade portion of the cap extends downwardly between the pages of a book, and that the writing implement (in the case of claims 1 and 14) or the body portion of the cap (in the case of claim 12) extends downwardly along an outside of a book spine. Thus, using the blade portion as a bookmark is not merely a statement of intended use. In any event, even if the relationships between the cap and the book called for in the claims were considered to be functional statements directed to the intended use of the claimed device, they cannot be casually dismissed as the examiner has done here. Rather, one should consider whether or not the reference structure reasonably appears to be capable of functioning in the manner called for in the claims. *See, for example, In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971). In the present case, the examiner has made no such inquiry.

Second, and more importantly, we do not share the examiner's views regarding the relevance of Downes and Manzardo to the

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claimed subject matter. An objective of Downes is to convert the pencil of a notebook into a page marker by rigidly connecting a tubular clip or "cap" to the back of the book so that the tip of a pencil may be received therein and the body of the pencil held between the notebook's pages. To this end, the tubular clip is provided with sharp prongs *f* or rivets (not shown) for rigidly fastening the clip to the notebook's back. Manzardo, on the other hand, does not disclose a cap for a writing implement for any purpose, much less a cap for a writing implement that additionally functions as a bookmark. Rather, Manzardo discloses a specialized writing implement having a tab (element A_1 in the Figure 1 embodiment, element C_1 in the Figure 2 embodiment, element E_1 in the Figure 3 embodiment) at the end opposite the writing tip, which tab acts as a bookmark. In order to hold the writing implement in proper position so that the tab can function in the manner intended, Manzardo provides a "cartridge" on either the front edge of the cover (see element F_2 in Figure 7) or the spine (see, for example, element B_1 in Figure 4) for receipt of the writing implement. Translation, page 2, lines 9-10 and 18-20; page 3, lines 15 and 25-26; page 4, lines 13-15; page 5, lines 3-4.

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Given the differences in structure and function of the devices of Downes and Manzardo, it is not at all apparent to us, and the examiner has not adequately explained, how he proposes to modify Downes in view of Manzardo's teachings to arrive at the claimed subject matter (i.e., a *cap* having a blade portion extending between the pages of a book). In contrast to the appellant's device, wherein the *cap* of a writing implement is used as a bookmark, Downes and Manzardo are directed to alternative arrangements wherein the *writing implement* itself is used as a bookmark. Furthermore, absent appellant's disclosure, it is not clear to us *why* one of ordinary skill in the art would have been motivated to undertake any such modification of one of these references in view of the other.

Where prior art references require a selective combination to render obvious a claimed invention, there must be some reason for the combination other than hindsight gleaned from the invention disclosure, *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). In the fact situation before us, we are unable to agree with the examiner that one of ordinary skill in the art would have been motivated to combine the teachings of Downes with those of Manzardo in a manner which would have resulted in the claimed subject matter.

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We have also carefully reviewed the Neidhardt reference additionally relied upon by the examiner but find nothing therein that makes up for the deficiencies of Downes and Manzardo discussed above.

In light of the foregoing, we will not sustain the standing rejection of the appealed claims under 35 U.S.C. § 103.

New Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejections.

Claims 1-5 and 12-14 are rejected under 35 U.S.C. § 112, first paragraph, as being based on an original disclosure that does not provide descriptive support for the invention as now claimed.

With respect to the written description requirement found in the first paragraph of 35 U.S.C. § 112,

[t]he test for determining compliance . . . [therewith] is whether the disclosure of the application as *originally filed* reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. The content of the drawings may also be considered in determining compliance with the written description requirement.

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In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citations omitted; emphasis added).

In the present application, appellant added to each of the independent claims the limitation that the blade portion of the cap extends in a plane which is generally perpendicular to a centerline of the body portion. We believe one of ordinary skill in the art, upon review of appellant's specification and drawing figures, would consider the centerline of body portion 23 to be an axial line passing through the center of the body portion of the cap, such that the blade 26 extends radially in a plane which includes the centerline of the body portion, rather than perpendicular thereto. Based on this interpretation of what constitutes the centerline of the body portion 23, there is no descriptive support in the original disclosure for the invention as now claimed.⁴

⁴We are aware of the amendment to the drawings proposed by appellant adding line 27 to Figures 3 and 4, and the corresponding amendment to the specification describing line 27 as a "longitudinal centerline" of the body portion. In our view, these amendments are inconsistent with that which was originally disclosed. In any event, these changes have no effect on appellant's original disclosure, which is the standard used for determining compliance with the description requirement found in the first paragraph of 35 U.S.C. § 112.

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Claims 1-5 and 12-14 are also rejected under 35 U.S.C. § 112, second paragraph. In order to satisfy the second paragraph of § 112, a claim must accurately define the claimed subject matter in the technical sense. See *In re Knowlton*, 481 F.2d 1357, 1365, 178 USPQ 486, 492 (CCPA 1973). Moreover, while the claim language may appear, for the most part, to be understandable when read in the abstract, no claim may be read apart from and independent of the supporting disclosure on which it is based. *In re Cohn*, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971); *In re Moore*, 439 F.2d 1232, 1235 n.2, 169 USPQ 236, 238 n.2 (CCPA 1971). Applying these principles to the present case, the claim language "extending in a plane which is generally perpendicular to a centerline of said body portion" appearing in each of the independent claims may appear to be clear when read in a vacuum. However, when read in light of the supporting disclosure, and especially the drawing figures, this claim language raises an unreasonable degree of uncertainty as to what the claim language may mean.

Summary

The standing rejection of claims 12 and 13 under 35 U.S.C. § 112, second paragraph, is affirmed.

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The standing rejection of claims 1-5 and 12-14 under 35 U.S.C. § 103 is reversed.

Pursuant to 37 CFR § 1.196(b), new rejections of claims 1-5 and 12-14 have been made.

The decision of the examiner is affirmed-in-part.

The new rejections under 37 CFR § 1.196(b) should not be considered final for the purpose of judicial review.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date hereof. 37 CFR § 1.197.

With respect to the new rejections under 37 CFR § 1.196(b), should appellant elect the alternate option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

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If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART, 1.196(b)

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Administrative Patent Judge)	
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WILLIAM E. LYDDANE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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